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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,560	03/23/2004	David L. Marvit	073338.0195 (04-50467 FLA	4252
5073	7590	10/31/2006	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			LIANG, REGINA	
			ART UNIT	PAPER NUMBER
			2629	

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/807,560

Applicant(s)

MARVIT ET AL.

Examiner

Regina Liang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/23/04, 11/21/05</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 15-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 15-20 although written to include a computer readable medium, however for a logic, i.e., computer program, to be statutory subject is must be claimed as a computer program stored on a computer readable medium as set forth in page 52 of the Interim Guidelines, thus without such the claims are non-statutory in nature.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending application No. 10/807,589. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are claiming a similar subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is an example for comparing claim 1 of this application and claim 1 of copending application 10/807,589.

claim 1 of this application	claim 1 of copending application 10/807589
a motion controlled handheld device comprising:	a motion controlled handheld device comprising:
a display having a viewable surface and operable to generate an image;	a display having a viewable surface and operable to generate an image;
a gesture database maintaining a plurality of predefined gestures, each gesture defined by a motion of the device with respect to a first position of the device;	a gesture database maintaining a plurality of gestures, each gesture defined by a motion of the device with respect to a first position of the device;
an application having a plurality of predefined commands;	a plurality of applications each having a plurality of predefined commands;

a motion detection module operable to detect motion of the handheld device within three dimensions and to identify components of the motion in relation to the viewable surface;	a motion detection module operable to detect motion of the handheld device within three dimensions and to identify components of the motion in relation to the viewable surface;
a user interface operable to receive user input associating selected ones of the gestures with corresponding ones of the commands;	
a gesture mapping database comprising a command map for the application, the command map comprising mappings of the selected gestures to the corresponding commands as indicated by the user input;	a gesture mapping database comprising a plurality of command maps, each of the command maps corresponding to a particular one of the applications and mapping each of the predefined commands to one of the gestures;

a control module operable to load the application, to track movement of the handheld device using the motion detection module, to compare the tracked movement against the gestures to determine a matching one of the gestures, to identify, using the command map, the command mapped to the	a control module operable to load one of the applications, to select one of the command maps corresponding to the loaded application, to track movement of the handheld device using the motion detection module, to compare the tracked movement against the gestures to determine a matching gesture, to
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matching gesture, and to perform the identified command using the application.	identify, using the selected command map, the predefined command mapped to the matching gesture, and to perform the identified command using the loaded application.
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As can be seen above, claim 1 of the copending application does not have a user interface, however, it would have been obvious to realize claim 1 of the copending application having a user interface since this permits the user to gesture with the device to input commands or data.

5. Claims 1-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending application No. 10/807,572. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are claiming a similar subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is an example for comparing claim 1 of this application and claim 1 of copending application 10/807,572.

claim 1 of this application	claim 1 of copending application 10/807,572
a motion controlled handheld device comprising:	a motion controlled handheld device comprising:

a display having a viewable surface and operable to generate an image;	a display having a viewable surface and operable to generate an image;
a gesture database maintaining a plurality of predefined gestures, each gesture defined by a motion of the device with respect to a first position of the device;	a gesture database maintaining a plurality of gestures, each gesture defined by a motion of the device with respect to a first position of the device, the gestures comprising symbol gestures each corresponding to a character from a preexisting character set;
an application having a plurality of predefined commands;	an application database maintaining at least one application;
a motion detection module operable to detect motion of the handheld device within three dimensions and to identify components of the motion in relation to the viewable surface;	a motion detection module operable to detect motion of the handheld device within three dimensions and to identify components of the motion in relation to the viewable surface;
a user interface operable to receive user input associating selected ones of the gestures with corresponding ones of the commands;	
a gesture mapping database comprising a command map for the application, the command map comprising mappings of the	a gesture mapping database comprising a gesture input map for the application, the gesture input map comprising mappings of

selected gestures to the corresponding commands as indicated by the user input;	the system gestures to corresponding inputs for the application;
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a control module operable to load the application, to track movement of the handheld device using the motion detection module, to compare the tracked movement against the gestures to determine a matching one of the gestures, to identify, using the command map, the command mapped to the matching gesture, and to perform the identified command using the application.	a control module operable to load the application, to track movement of the handheld device using the motion detection module, to compare the tracked movement against the symbol gestures to identify a matching symbol gesture, to identify, using the gesture input map, the corresponding input mapped to the matching symbol gesture, and to provide the corresponding input to the application.
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As can be seen above, claim 1 of the copending application does not have a user interface, however, it would have been obvious to realize claim 1 of the copending application having a user interface since this permits the user to gesture with the device to input commands or data.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 7-10, 14-17, 20, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Mosttov (WO 03/001340).

As to claims 1, 21, Mosttov discloses a motion controlled handheld device (Fig. 1) comprising:

a display having a viewable surface and operable to generate an image;

a gesture database (the gesture recognition system 15 in Fig. 2) maintaining a plurality of predefined gestures, each gesture defined by a motion of the device with respect to a first position of the device (see page 6, lines 22-28; page 7, line 29 to page 8, line 2);

an application (28 in Fig. 2) having a plurality of predefined commands (page 8, lines 8-16);

a motion detection module (sensors 12 in Fig. 2) operable to detect motion of the handheld device within three dimensions and to identify components of the motion in relation to the viewable surface (page 7, lines 16-25);

a user interface operable to receive user input associating selected ones of the gestures with corresponding ones of the commands (page 6, lines 26-28);

a gesture mapping database (24 in Fig. 2) comprising a command map for the application (page 8, lines 17-23), the command map comprising mappings of the selected gestures to the corresponding commands as indicated by the user input (page 8, lines 24-28); and

a control module (Fig. 2) operable to load the application, to track movement of the handheld device using the motion detection module (12), to compare the tracked movement against the gestures to determine a matching one of the gestures, to identify, using the command

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map, the command mapped to the matching gesture, and to perform the identified command using the application (see page 7, line 26 to page 8, line 34 for example).

As to claim 2, Fig. 2-4 of Mosttov teaches the user input identifies a particular one of the gestures and a plurality of predefined commands; the command map further comprises a mapping of the identified gesture to the identified plurality of the predefined commands; and a control module is operable, in response to the matching gesture being the particular one of the gestures, to perform each of the plurality of the predefined commands (page 7, line 26 to page 8, line 34).

As to claim 3, Mosttov teaches the application has a first application state and a second application state, the command map for the application, in response to a same gesture, maps a first predefined commands in the first application state and a second predefined command in the second application state (page 8, lines 8-12).

As to claim 7, Fig. 5 of Mosttov teaches the device comprising three accelerometers (40) for detecting acceleration along three axis, the gesture database, the motion detection module and the control module as claimed.

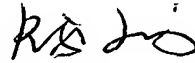
Claims 8-10, 14-17, 20, which are method claims corresponding to the above apparatus claims 1-3, 7, are rejected for the same reasons as stated above since such method "steps" are clearly read on by the corresponding "means".

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina Liang whose telephone number is (571) 272-7693. The examiner can normally be reached on Monday-Friday from 8AM to 5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (571) 272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Regina Liang  
Primary Examiner  
Art Unit 2674

10/25/06